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In re Application of: : COMMUNICATION
DAVID, Christian, et al. :
U.S. App. No.: 10/540,754 :
Filing Date: June 24, 2005 :
Attorney's Docket No.: 2003P07571WOUS :
For: METHOD FOR GENERATING A :
CIRCULAR PERIODIC STRUCTURE :
ON A BASIC SUPPORT MATERIAL :
:

This application is before the Office of PCT Legal Administration for issues arising under 35 U.S.C. 371.

BACKGROUND

On June 24, 2005, applicants filed materials to initiate the present application, including a "Transmittal Letter To The United States Designated/Elected Office (DO/EO/US) Concerning A Submission Under 35 U.S.C. 371" (Form PTO-1390), a specification (description, claims, drawings and abstract), a fee payment, and an application data sheet (ADS).

The Form PTO-1390 Transmittal letter filed by applicants on June 24, 2005 identified the application as the U.S. national stage under 35 U.S.C. 371 of international application PCT/EP2003/010233; however, the ADS identified the application as a continuation of PCT/EP2003/010233. In addition, the first line of the description identified the application as "a continuation of International Application PCT/EP2003/010233, filed 09/15/2003."

The materials filed on August 20, 2007 were assigned U.S. application number 10/540,754 and, based on the use of the Form PTO-1390 Transmittal Letter, were initiated as the U.S. national stage of PCT/EP2003/010233.

On October 28, 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497 and additional fees.

On December 23, 2005, applicants filed a response to the Notification Of Missing Requirements that included the required declaration.

On January 18, 2006, the DO/EO/US mailed a “Notification Of Acceptance” (Form PCT/DO/EO/903) indicating that applicants had satisfied the requirements of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) as of December 23, 2005.

On December 01, 2009, a “Notice Of Allowance And Fee(s) Due” (Form PTOL-85) and a “Notice Of Allowability” (Form PTOL-37) were issued.

On March 01, 2010, applicants submitted payment of the Issue and Publication Fees.

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). See 37 CFR 1.495(g):

The documents and fees submitted ... must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

In addition, section 1893.03(a) of the MPEP states the following:

If there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).

The MPEP goes on to state that “conflicting instruction will be present, for example, where applicant includes in the initial submission under 35 U.S.C. 371 ... a benefit claim under 35 U.S.C. 120 to the international application.”

Here, the information provided by applicant in the PTO-1390 Transmittal Letter filed on June 24, 2005 identified the application as a national stage under 35 U.S.C. 371; however, the ADS and specification included with the original submission both contain a domestic benefit claim identifying the present application as a continuation of the international application. The inclusion of the domestic benefit claim to the international application under 35 U.S.C. 120 is inconsistent with the intent to enter the National State under 35 U.S.C. 371 and, as set forth in the MPEP, constitutes a conflicting instruction.

Based on the above, the present application is properly treated as a filing under 35 U.S.C. 111(a), not a national stage application under 35 U.S.C. 371. Because the materials filed June 24, 2005 included all the requirements for obtaining a filing date in an application filed under 35 U.S.C. 111(a), the appropriate filing date for the present application is June 24, 2005.

CONCLUSION

The present application will be treated as a U.S. application filed under 35 U.S.C. 111(a) as a continuation of international application PCT/EP2003/010233. The application has a filing date of June 24, 2005.

The "Notification Of Acceptance" (Form PCT/DO/EO/903) and filing receipt mailed January 18, 2006, which identified the present application as a national stage application filed under 35 U.S.C. 371, are hereby **VACATED**.

The application is being referred to the Office Of Patent Application Processing (OPAP) for further processing consistent with treating the present application as an application filed under 35 U.S.C. 111(a) as a continuation of international application PCT/EP2003/010233 with a filing date of June 24, 2005.

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